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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,843	04/06/2006	Shinichi Yanagi	288920US0PCT	5093
22850	7590	03/02/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			OLADAPO, TAIWO	
			ART UNIT	PAPER NUMBER
			1797	
			NOTIFICATION DATE	DELIVERY MODE
			03/02/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/574,843	Applicant(s) YANAGI ET AL.	
	Examiner TAIWO OLADAPO	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8 and 11-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8 and 11-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment dated 11/02/2009 has been considered and entered for the record. The amendment does not overcome the previous rejections which are hereby maintained. New rejections are made in view of new claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5 – 8, 14 – 23, are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi (US 4,483,775)

4. In regards to claims 1, 3, Yamaguchi teaches a lubricating oil additive comprising a reaction product or complex of a metal salt of diisopropyl dithiophosphoric acid and (component A) and succinimide (component B) (column 1 line 50 – column 2 line 25). The metal salt of diisopropyl dithiophosphoric acid is a phosphosulfurized hydrocarbon having two alkyl groups having ether bonds with a phosphorus compound (column 1 lines 50 – 67 structure).

5. In regards to claim 5, Yamaguchi teaches the lubricating oil additive, wherein the alkyl groups have 6 carbon atoms which meets the claimed limitation (column 1 lines 50 – 67 structure).

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6. In regards to claim 6, Yamaguchi teaches a lubricating oil composition wherein the oil is derived from petroleum or synthetic sources, which are mineral and synthetic oils (column 6 lines 60 – 65).

7. In regards to claims 7, 8, 23, Yamaguchi teaches the lubricating oil comprising the base oil and phospho-sulfurized hydrocarbon additives according to the claimed invention, which are suitable as automatic transmission or continuously variable transmission fluids for wet clutches or wet brakes.

8. In regards to claims 14, 15, Yamaguchi teaches the lubricating oil composition wherein the phospho-sulfurized hydrocarbon (diisopropyl dithiophosphoric acid) and succinimide additive is present in the amount of preferably 1.5 to about 6 wt. % (column 4 lines 58 – 61).

9. In regards to claims 16, 17, Yamaguchi teaches the lubricating oil composition which comprises mineral or synthetic oil as previously stated.

10. In regards to claims 18 – 22, Yamaguchi teaches the lubricating oil having mineral or synthetic base oil and the reaction product as claimed, thus intrinsically having the viscosity and acid contents $\%C_A$ in the range(s) recited. “Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

11. Claims 1, 6 – 8, 11 – 20, 24, 25, are rejected under 35 U.S.C. 102(b) as being anticipated by Ryer et al. (EP 0 348 236 A2)

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12. In regards to claims 1, 6, 11 – 13, 16, 24, 25, Ryer teaches a lubricating oil composition comprising a dispersant additive, wherein the oil can be mineral or synthetic oil (page 14 lines 20, 32), and the dispersant additive is a reaction product of succinimide and phosphosulfurized hydrocarbon prepared by reacting i.e. P_2S_5 and α or β -pinene which meets the limitations of the claim (abstract, page 13 lines 31 – 40, Example 1). The reaction product of pinene and olefin taught by Ryer is a phospho sulfurized hydrocarbon having two alkyl groups attached to a phosphorus atom and meets the limitation of claim 25 as evidenced by the applicant's specification (Applicant's Specification page 6 lines 5 – 17).

13. In regards to claims 7, 8, 17 – 20, Ryer teaches the composition used for power transmission fluids etc, which is suitable for lubricating continuously variable transmissions, wet clutches, wet brakes etc (page 14 lines 20 – 28). The viscosity of the base oil ranges from preferably about 3.5 to 5cst at 100°C which meets the limitations in claims 18 – 20.

14. In regards to claims 14, 15, Ryer teaches the composition wherein the lubricating oil comprises the dispersant in the amount of from 0.1 – 7% (page 18, Table 3).

Response to Arguments

15. Applicant's arguments have been fully considered but are not persuasive.

16. The applicant argues that Yamaguchi and Ryer do not teach the limitation of the newly added claims 24 and 25, which require that the phospho sulfurized hydrocarbon compound is produced using a phosphorus sulfide group, or is a group having two alkyls attached to a phosphorus atom. This argument is irrelevant as Yamaguchi is not currently used in rejecting claims 24, 25. Furthermore, applicant fails to make substantive arguments as to why Yamaguchi

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and/or Ryer fail to anticipate or render obvious the previously rejected claims. As discussed above, Ryer teaches phospho sulfurized hydrocarbon compounds prepared from pinene and phosphorus pentasulfide which the applicants specification teaches are phospho sulfurized hydrocarbon compounds having two alkyl groups attached to a phosphorus compound (Applicant's specification page 6 lines 5 – 17).

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797